

REMARKS

I. Status of Claims

Claims 42-119 are pending in this application. Claims 54-59, and 88-119 are withdrawn, as directed to non-elected subject matter. Applicants respectfully remind the Office of the duty of rejoinder, and of the duty to expand the search to non-elected species after the elected species has been found to be allowable. See M.P.E.P. § 803.02 and 35 U.S.C. § 121.

No amendments are presented herein.

II. Rejection under 35 U.S.C. § 102(b)

The Office rejects claims 42-53, and 60-87 under 35 U.S.C. § 102(e) as allegedly “anticipated by” U.S. Patent No. 7,211,244 to Auguste (“Auguste”). Office Action at 3. The Office contends that Auguste discloses in different sections of its specification the claimed components (e.g., “col. 12. ll. 8-54 for volatile oil,” and “col. 14, line 12 for elected species camauba wax,” etc.) and amounts (e.g., “amount of volatile oil (claims 45-51)”, etc.). Office Action at 3-4. Thus, after picking and choosing elements throughout the disclosure, the Office concludes that Auguste “teaches mascara compositions using the same ingredients claimed.”. See *id.* at 4. Applicants respectfully disagree and traverse the rejection in view of the following reasons.

For a reference to anticipate, it must “clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures” *In re Arkley*, 455 F.2d

586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). In other words, one of ordinary skill in the art must be able to "at once envisage" the invention as claimed. See M.P.E.P. § 2131.02

In *Arkley*, the court found that a single claimed compound was not described in the prior art within the meaning of § 102, because the prior art generically disclosed a class of compounds encompassing the claimed compound, as well as over 230,000 other compounds. The Board of Patent Appeals and Interferences ("Board") had contended, however, that the prior art contained two examples that disclosed the exact precursors of the claimed compound. Nevertheless, the court found that these examples disclosed exact precursors only to the extent that one selects the correct acid to react with a particular tertiary amine, which also must be selected. See *id.* 455 F.2d at 588, 172 USPQ at 526. The court further found that there was nothing in the reference that "'clearly and unequivocally' directs those skilled in the art to make this selection[.]" *Id.* Thus, the court reversed the rejection under § 102. Here, to arrive at the presently claimed invention, the Office must undergo improper picking and choosing from among a myriad of embodiments disclosed in *Auguste*.

For example, *Auguste* teaches that the compositions *may* comprise water and a volatile oil ("[t]he volatile solvent present in the composition according to the invention may be chosen from water, the volatile organic solvents defined below, the volatile oils defined below, and mixtures thereof"). *Id.* at col. 6, ll. 28-32. *Auguste* further teaches an *optional* aqueous phase, which again *may* be chosen from water and/or other water-

miscible organic solvents. See Auguste at col. 11, ll. 50-67. Moreover, if water (or an aqueous phase) is indeed added to the compositions therein, Auguste teaches a broad range of amount to be added (0.1% to 98% by weight). See e.g., col. 11, ll. 65-67. However, Auguste does not “clearly and unequivocally disclose” the claimed water /or water soluble solvent component in an amount up to 20% by weight. Applicants note that the exemplified compositions disclose water, and propylene glycol in amounts much higher than the claimed amount (Examples 1 and 3 - 64%; Example 4 - 61%). Moreover, none of these exemplified compositions comprise at least one volatile oil as claimed.

Further, the claimed wax component that the Office contends Auguste teaches, is merely an optional ingredient. See Auguste at col. 5, ll. 19-22. Indeed, waxes are listed as possible “secondary particles,” which themselves are merely optional. See Auguste at col. 3, ll. 45-65. Thus, nowhere does Auguste show the identical invention in as complete detail as currently claimed. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, (Fed. Cir. 1989).

Moreover, in *Net MoneyIn, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1373 (Fed. Cir. October 20, 2008), the Federal Circuit disagreed with an argument for anticipation similar to the one the Examiner is making in the present case, wherein all elements are simply present in the four corners of the document:

VeriSign responds that the district court did not improperly rearrange the links in the iKP reference, but rather “merely relied on various express teachings from a single document

that together completely disclose the five claimed links." Appellees' Br. at 61. Under VeriSign's theory, this was sufficient to establish anticipation, because all that is required is "that the four corners of a single, prior art document describe every element of the claimed invention." *Id.* at 61-62 (quoting *Xerox Corp. v. 3Com Corp.*, 458 F.3d 1310, 1322 (Fed.Cir.2006)). **We disagree with VeriSign, and take this opportunity to clarify what a reference must show in order to anticipate a claimed invention.**

Id. at 1369 (emphasis added).

Thus, in the *Net Money/IN* decision, the court reemphasized the importance of the requirement that the reference describe not only the elements of the claimed invention, but also that it describe those elements "arranged as in the claim":

To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation.... But disclosure of each element is not quite enough-this court has long held that "[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention *arranged as in the claim.*"

Id. at 1371 (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d at 1548). The court further stated that:

In all of these cases, the prior art reference had to show the claimed invention arranged or combined in the same way as recited in the claim in order to anticipate. We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Id. Regarding the meaning of "arranged as in the claim", the court make it clear that:

The meaning of the expression "arranged as in the claim" is readily understood in relation to claims drawn to things such as ingredients mixed in some claimed order. In such instances, **a reference that discloses all of the claimed ingredients, but not in the order claimed, would not anticipate, because the reference would be missing any disclosure of the limitations of the claimed invention "arranged as in the claim."** . . . our precedent informs that the "arranged as in the claim" requirement applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. The test is thus more accurately understood to mean "arranged or combined in the same way as in the claim."

Id. at 1370 (emphasis added).

With this legal standard in mind, Applicant respectfully submits that, because Auguste lacks a certain degree of precision with respect to the specific elements claimed, requisite to a § 102 rejection, the rejection is in error and Applicants therefore respectfully request its withdrawal.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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